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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,334	06/22/2005	Jurgen Leib	2133.060USU	2382

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EXAMINER

FOURSON III, GEORGE R

ART UNIT	PAPER NUMBER
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2823

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08/11/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/511,334	LEIB ET AL.	
	Examiner	Art Unit	
	George Fourson	2823	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-12, 14, 16, 19-26, 28, 31, 33 and 35 is/are rejected.
- 7) ☒ Claim(s) 9, 13, 15, 17, 18, 27, 29, 30, 32, 34 and 36-40 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/15/04</u> . | 6) <input type="checkbox"/> Other: _____ |

Applicant's traversal of the restriction requirement is moot in view of the cancellation of claims drawn to group II.

Claims 1,21-27 and 34 are objected to because of the following informalities: In claims 1 and 21-27 "patterned" has been misspelled. In claim 34, "inductance" should be replaced by - - inductor - - because inductance is a property. Appropriate correction is required.

Claim 4 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The recitation of depositing an "evaporation-coating glass" in claim 1 is seen to require forming a glass or vitreous structure by an evaporation deposition process.

Claim 7 is further limiting only in recitation of "single source" and as such is free of objection.

Claims 3 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 3, it is not clear what is recited through use of "wafer assembly". In claim 31, it is not clear what is recited through use of "defines".

Applicant is advised that should claim 16 be found allowable, claim 20 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9,14,16,19,20,25-27 and 35 are rejected on the ground of nonstatutory

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obviousness-type double patenting as being unpatentable over 1-22 of U.S. Patent No. 7326446. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are generic to those of the patent (see MPEP 806.04(i)).

Claims 1,2,4,5,14,18,20 and 35 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,5-7 and 23 of U.S. Patent Application No. 10515035. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are generic to those of the application. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,2,3,4,6,7,12,14,16,19,20,22,23,25,26,28,31,33 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Pliskin et al 4506435.

Pliskin et al discloses forming negatively patterned first coating 10/12 using resist patterning by photolithography to expose plural regions of a substrate surface (col.3, lines 61-68 and column 8, line18), depositing binary evaporation coating glass 20 (tables I,II and III) using e-beam evaporation on the remaining portion of 10/12 and the surface exposed by 10/12 (col.6, line 27 and col.7 line 18), reflowing 20 (col.4, line 49 and col.7 lines 44-47), removing 20 by etching and removing 10/12 to expose a channel region of a transistor which necessarily includes conductive gate and contact regions (col.7, line 65 – col.8, line 60).

Claims 5,8,10,11 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over claims Pliskin et al '435 as applied to claims 1,2,3,4,6,7,12,14,16, 19,20,23,25,26,28,31,33 and 35 above, and further in view of the following argument.

The examiner takes official notice that plasma ion-enhance evaporation coating was known as an evaporation method of forming glass layers such as those of Pliskin et al prior to applicant's invention.

The examiner takes official notice that co-evaporation to form glass layers such as those of Pliskin et al was known prior to applicant's invention.

The examiner takes official notice that wet-chemical etching and solvent removal of silicon nitride was known prior to applicant's invention.

It would have been obvious to one of ordinary skill in the art to combine the teachings of Pliskin et al and the prior art methods to enable the evaporation coating step and patterning of 10/12 to be performed according to the prior art methods because in such a process the prior art methods would be used according to its known intended purpose and would have reasonably been expected by one of ordinary skill in the art to yield the predictable results of evaporation coating step and patterning of 10/12.

Pliskin et al discloses CVD or sputtering as methods of forming the glass layer 20 (col.7, lines 9-43). In view of the disclosure that either of these methods or evaporation is disclosed as suitable in forming the entire layer 20 it would have been obvious to one of ordinary skill in the art to form a portion of the layer using sputtering or CVD and the remaining portion using evaporation.

Claims 1-4 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over IBM Technical Disclosure Bulletin XP-002264775.

IBM Technical Disclosure Bulletin XP-002264775 discloses forming patterned lift-off mask (dotted lines in figure 3), forming evaporation glass on the lift off mask and removing the glass and lift-off mask in a lift-off process (steps 5-7).

Claims 9,13,15,17,18,27,29,30,32,34 and 36-40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in

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independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Fourson whose telephone number is (571) 272-1860. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Smith, can be reached on (571) 272-1907. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/George Fourson/
Primary Examiner, Art Unit 2823

GFourson
August 11, 2009